

## **REMARKS/ARGUMENTS**

In the outstanding Final Office Action, Claims 1-30 were examined. Claims 1-30 were rejected. In response to the above-identified Final Office Action, Claims 1, 11, 21 and 27 are amended. Entry of the amendments is respectfully requested. Applicants respectfully request reconsideration in view of the aforementioned amendments and the following remarks.

### **I. Claims Rejected Under 35 U.S.C. § 101**

Examiner rejects Claims 1, 11, 21 and 27 under 35 U.S.C. § 101 because Examiner believes these claims are directed to non-statutory subject matter. In response, Applicants amend these claims based on Examiner's suggestion.

The relevant part of Claim 1 now recites "reclaiming said work item **by updating a memory, freeing a memory, or reusing a memory after** said coherency signal is generated." The amended Claim 1 now provides a tangible result and thus complies with the Interim Guidelines published on October 26, 2005. Accordingly, reconsideration and withdrawal of the 35 U.S.C § 101 rejection of Claim 1 are respectfully requested.

Applicants amend Claims 11, 21 and 27 under similar rationale. These claims now also provide a tangible result. Consequently, reconsideration and withdrawal of the 35 U.S.C § 101 rejection of Claims 11, 21 and 27 are respectfully requested.

### **II. Claims Rejected Under 35 U.S.C § 102(a) and § 102 (f)**

A. Claims 1-10 and 21-30 are rejected under 35 U.S.C. § 102(a) as being anticipated over Howard et al. ("Howard") (Enhanced Host Controller Interface Specification for Universal Serial Bus - Revision 0.95). In response, Applicants respectfully traverse this rejection for the following reasons.

35 U.S.C. § 102 (a) states that: “A person shall be entitled to a patent unless--  
(a) the invention was known or used *by others* in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent” (emphasis added).

Applicants contend that Howard is not a proper prior art reference under § 102(a) because the subject matter is derived from Applicants’ own original work and thus is not an invention known or used *by others*. To substantiate this contention, Applicants submit Declarations under Rule 1.132 from each inventor to traverse the §102(a) rejection of Claims 1-10 and 21-30. See also In Re Katz, which established that Applicant’s disclosure of his or her own work *within the year* before the Applicant’s filing date cannot be used against him or her under 35 U.S.C. §102(a). In Re Katz, 687, F.2d 450, 215 U.S.P.Q. 14 (CCPA 1982) (emphasis added).<sup>1</sup>

Therefore, Howard is not a prior art reference. Id. See M.P.E.P. §2132.01 and M.P.E.P. §715.10. Because Howard is not a prior art reference, Claims 1, 21 and 27 are not anticipated under §102(a). Consequently, reconsideration and withdrawal of the § 102(a) rejection of Claims 1, 21 and 27 are respectfully requested.

Claims 2-9 depend from Claim 1 and therefore include all the limitations of Claim 1. Accordingly, Claims 2-9, based on their dependency from Claim 1, are also patentable over the references of record. Consequently, reconsideration and withdrawal of the § 102(a) rejection of Claims 2-9 are respectfully requested.

Likewise, Claims 22-26 depend from Claim 21 and therefore include all the limitations of Claim 21. Accordingly, Claims 22-26, based on their dependency from Claim 21, are also patentable over the references of record. Consequently, reconsideration and withdrawal of the § 102(a) rejection of Claims 22-26 are respectfully requested.

Similarly, Claims 28-30 depend from Claim 27 and therefore include all the limitations of Claim 27. Accordingly, Claims 28-30, based on their dependency from Claim 27, are also

---

<sup>1</sup> Howard’s publication date is November 20, 2000. The patent application is filed on June 29, 2001, which is within one year after Howard’s publication.

patentable over the references of record. Consequently, reconsideration and withdrawal of the § 102(a) rejection of Claims 28-30 are respectfully requested.

**B.** Claims 1-30 are rejected under 35 U.S.C. § 102(f) over Howard because Examiner believes Applicants did not invent the claimed subject matter. In response, Applicants respectfully submit Declarations under Rule 1.132 to traverse the § 102(f). The Declarations set forth that only Mr. Abramson and Mr. Howard are the sole inventors of the relevant material of Howard. Consequently, reconsideration and withdrawal of the § 102(f) rejection of Claims 1-30 are respectfully requested.

### **III. Claims Rejected Under 35 U.S.C. § 103(a)**

Examiner rejects Claims 11-20 under 35 U.S.C. § 103(a) as being unpatentable over Howard in view of U. S. Patent No. 4,135,240 issued to Ritchie ("Ritchie"). In response, Applicants respectfully traverse this rejection based on the following remarks.

To establish a *prima facie* case of obviousness, the following criteria must be met: (1) there must be some suggestion or motivation to modify the reference or combine the reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art references must teach or suggest all the claim limitations (*see* MPEP § 2142).

As indicated above with reference to the rejection of Claims 1-10 and 21-30, Howard does not qualify as a prior art reference under 35 U.S.C. § 102(a). *Id.* Based on the Declaration accompanying this response, Applicants have established that Howard discloses subject matter derived from Applicants' own original work. Therefore, Howard is not a prior art reference. Accordingly, since Examiner cannot rely on Howard, Examiner fails to establish a *prima facie* § 103(a) rejection of Claim 11.

The addition of Ritchie does not cure the deficiency caused by the absence of Howard. Examiner has not relied upon and Applicants have been unable to discern any part of Ritchie that teaches "removing a work item of a plurality of work items from an enabled expansion bus schedule data structure; generating a coherency signal independent of said work item utilizing an expansion bus host controller in response to removing said work item from said enabled

expansion bus schedule data structure; and reclaiming resources assigned to said work item whenever said coherency signal is generated.” Consequently, reconsideration and withdrawal of the § 103(a) rejection of Claim 11 are respectfully requested.

Claims 12-20 depend from Claim 11 and therefore include all the limitations of Claim 11. Accordingly, Claims 12-20, based on their dependency from Claim 11, are also patentable over the references of record. Consequently, reconsideration and withdrawal of the § 103(a) rejection of Claims 12-20 are respectfully requested.

### CONCLUSION

In view of the foregoing, it is submitted that claims 1-30 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

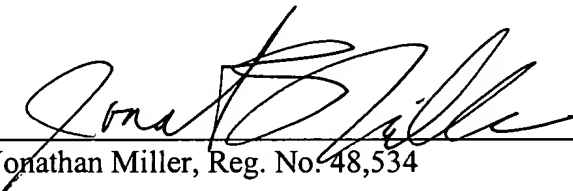
If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

Dated: October 18, 2006

By:

  
Jonathan Miller, Reg. No. 48,534

12400 Wilshire Boulevard  
Seventh Floor  
Los Angeles, California 90025  
(310) 207-3800

### **CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on October 18, 2006.

  
Jean Svoboda

**Attachments (2):** Declaration of Darren L. Abramson under 37 CFR § 1.132.  
Declaration of John S. Howard under 37 CFR § 1.132.